

Application Serial No.: 09/825,210
Filing Date: April 2, 2001

Reply to Office action of: 10/18/2005
Attorney Docket No.: ARC920010034US1

REMARKS

Applicant respectfully submits that all the claims presently on file are in condition for allowance, which action is earnestly solicited.

THE CLAIMS

CLAIM REJECTIONS - 35 USC §112

Claims 1, 5 - 11, and 15 - 26 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, objecting to the term "integral". Applicant respectfully traverses this rejection; nonetheless, Applicant amended the claims to delete the term "integral". The claims on file are thus in compliance with 35 USC 112, second paragraph.

CLAIM REJECTIONS - 35 USC §103

Claims 1, 5 - 7, 10, 11, 15 - 17, 20 - 23, and 26 were rejected under 35 U.S.C. 103(a) as being unpatentable over Logan (US 6665659 B1) hereinafter referred to as "Logan" and further in view of Heninger et al. (US 6470349 B1) hereinafter referred to as "Heninger." Applicant respectfully submits that the cited references do not disclose all the elements and limitations of the rejected claims. Consequently, the claims presently on file are not obvious in view of Logan and Heninger, whether considered individually or in combination with each other. In support of this position, Applicant submits the following arguments:

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A. Legal Standard of Obviousness

The following legal authorities set the general legal standards in support of Applicant's position of non obviousness, with emphasis added for added clarity:

- MPEP 706.02(j), "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) ... The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)."
- In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. The prior art perceived a need for mechanisms to dampen resonance, whereas the inventor eliminated the need for dampening via the one-piece gapless support structure. "Because that insight was contrary to the understandings and expectations of the art, the structure effectuating it would not have been obvious to those skilled in the art." 713 F.2d at 785, 218 USPQ at 700 (citations omitted).
- MPEP §2143.03, "All Claim Limitations Must Be Taught or Suggested: To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in

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judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)."

- MPEP §2143.01, "The Prior Art Must Suggest The Desirability Of The Claimed Invention: There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).
- "**Obviousness cannot be established** by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *In re Fine*, 837 F.2d at 1075, 5 USPQ2d at 1598 (citing *ACS Hosp. Sys. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)). What a reference teaches and whether it teaches toward or away from the claimed invention are questions of fact. See *Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 960-61, 220 USPQ 592, 599-600 (Fed. Cir. 1983), cert. denied, 469 U.S. 835, 83 L. Ed. 2d 69, 105 S. Ct. 127 (1984). "
- "When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references. See *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987)." Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See MPEP 2143.01; *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).
- "With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience -- or on its assessment of what would be basic

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knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings." See *In re Zurko*, 258 F.3d 1379 (Fed. Cir. 2001).

- "We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), *Para-Ordinance Mfg. v. SGS Imports Intern., Inc.*, 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), although "the suggestion more often comes from the teachings of the pertinent references," *Rouffet*, 149 F.3d at 1355, 47 USPQ2d at 1456. The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., *C.R. Bard*, 157 F.3d at 1352, 48 USPQ2d at 1232. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." E.g., *McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact."); *In re Sichert*, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977)." See *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999).
- "To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." See *In re Rouffet*, 149, F.3d 1350 (Fed. Cir. 1998).
- The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).

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- If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

B. Brief Summary of the Present Invention

B.1. Problems addressed by present invention

Prior to presenting substantive arguments in favor of the allowability of the claims on file, it might be desirable to summarize the present invention in view of the problem it addresses. Once a web document is saved, the Internet (or hyperlink) context from a source document to a destination document, passing by one or more intervening target documents, is lost. Consequently, the user will not be able to return from the destination document to the source document, nor would it be possible for the user to return to the download location of the document, since this information is also lost during the save process. Prior to the advent of the present invention, the need for such a save process, was not recognized, let alone provide a solution thereto.

B.2. Summary of the present invention

The document association system and method of the present invention satisfy this need by bundling (or associating) and synchronizing a target document (i.e., a web page) and the context of a source document as metadata to intervening target documents during a save process. Accordingly, users will be able to return to the source document, and optionally to use applications for automatically synchronizing a destination document to the target document.

The context of the source document may include, for example, one or

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more of the following parameters:

- The location or address, such as the URL, of the source document;
- the path, such as pages examined to navigate from the source document to the target document; and
- the input parameters required to generate the target document, such as the search query inputted by the user.

When a user wishes to access the source document, the system uses the saved context metadata to link the user to the source document. The system is also capable of synchronizing the target document(s) to the destination document. When coupled with a synchronization application, the system allows the user to update the destination document to reflect changes in the target document(s), allowing a convenient mechanism for updating saved documents. The synchronization application performs a comparison of the destination document with the target document to detect changes and to automatically update the destination document. If the target document were deleted from its original location or relocated, the destination document is marked as orphaned.

C. Application of the Obviousness Standard to the Present Invention

The foregoing obviousness standards will now be discussed in light of representative claim 1.

Logan generally describes a system for selectively distributing information from Internet resources to a user in a way that make it easier for the user to quickly identify information of particular interest. The system employs a server for generating a central library of citations, each containing metadata that

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describes selected information from a resource identified by a URL. The server works in conjunction with a client computer which requests information on a topic or topics of interest by supplying preference data to the server. In response, the server delivers a subset of the citations to the client computer which match the preference data from the client. The client computer places this subset of citations in a local store where they may be compared with user requests by matching the metadata in each citation to criteria specified by the user. In addition, the locally stored citations may be sorted into a particular order in response to a user request. The filtered and sorted citations may then be used to present desired information to the user, either by displaying metadata contained in the citation or by using the URL in the citation to fetch relevant information via the Internet from the original resource.

Applicant agrees with the Examiner that "Logan does not explicitly teach synchronizing." In essence, In essence, Logan fails to consider the claimed invention as a whole, since Logan's method does not perform the same or similar function, or provide the same or similar advantages, as the present invention.

Applicant respectfully submits that Logan describes a plurality of citations that describe selected information from the resources. This enables the user to retrieve relevant information from the original resource. The Examiner seems to analogize the citations in Logan to the destination documents of the instant claim 1.

Applicant submits that Logan does not describe destination documents that are synchronized with target documents. In addition, Logan does not describe

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intermediate documents whose absence does not affect the ability to return to the source document.

Furthermore, Applicant submits that the citations in Logan do not qualify as "documents" according to the present invention. In fact, Applicant has clearly and expressly defined the destination document as: "A final document or web page which is comprised of a target document that is bundled with contextual data about the source document." Since a citation does not qualify as either a document or a web page, Logan's citations do not qualify as documents within the meaning of the present invention.

As a substitute for the admittedly missing element in Logan, the Examiner resorts to Heninger, reasoning that: "Heninger et al. do teach that in the case of caches, it is also useful to generate a source command to be placed in your target script referring back to the source script. This ensures that the target stays synchronized with the source (Column 16, lines 16 – 20), compare with automatically synchronizing the destination document to the target document."

Applicant respectfully submits that it is unclear which documents the Examiner considers to be synchronized, since, as argued earlier, Logan's citations should not be analogized to the destination documents of the present invention, and additionally, Logan does not describe target documents that are synchronized with the destination documents. As a result, even if Heninger describes synchronization between documents, it still does not describe the synchronization between the target and destination documents, and thus Heninger does not consider the present invention as a whole.

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Applicant further respectfully submits that the present invention is not limited to the step of synchronizing in abstraction, but rather in combination with the remaining elements and features of claim 1. More specifically, the present invention recites automatically synchronizing the destination document to the target document, to reflect changes in the target document. The synchronization step, in conjunction with the bundling step, enable the present invention to track down the source document even if the intermediate documents change. This feature is not taught in the cited references, whether considered individually or in combination with each other, and none of the references suggests such combination. As a result, the two cited references cannot be properly combined.

Therefore based on the legal authorities above, neither Logan, Heninger, nor the combination thereof, describes the present invention as a whole, and consequently, claim 1, as amended is not obvious in view of these references. Claim 1 and the claims dependent thereon are allowable, and such allowance is respectfully requested. In addition, with respect to the dependent claims, Applicant does not assert each individual feature independently in abstraction, but rather in combination with the elements and features of claim 1.

Independent claims 11 and 20 are also allowable for reciting generally similar elements and limitations to those of claim 1. As a result, claims 11 and 20 and the claims dependent thereon are allowable and such allowance is respectfully requested.

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CONCLUSION

All the claims presently on file in the present application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned at the below-listed telephone number.

Respectfully submitted,

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